

REMARKSI. The 35 U.S.C. §103 RejectionsA. Claims 1-19 and 48

Claims 1-19 and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,136,501 to Silverman ("SILVERMAN") in view of U.S. Patent No. 5,758,328 to Giovannoli ("GIOVANNOLI"). Applicant respectfully traverses the rejections.

1. Claim 1

It is axiomatic that the combination of the cited references in a §103 rejection must disclose every element in the rejected claim. Claim 1 recites a method for providing highly automated procurement services, comprising:

- (a) accessing a database initialized with information regarding a plurality of trading partners:
 - (1) said plurality of trading partners including customer and non-customer trading partners;
 - (2) said information including trading relationship information and pricing information involving at least a customer trading partner and another of said trading partners;
- (b) receiving a purchase request of a first trading partner among said trading partners;
- (c) automatically selecting at least one qualified trading partner from said trading partners based on said purchase request;
- (d) generating a purchase order based on:
 - (1) a portion of said trading relationship information and pricing information pertaining to said at least one qualified trading partner;
 - (2) said purchase request; and
 - (3) without requiring direct communication between said first trading partner and said at least one qualified trading partner

and without revealing said pricing information to said first trading partner;

- (e) forwarding said purchase order to said at least one qualified trading partner;
- (f) receiving a notification pertaining to said at least one qualified trading partner;
and
- (g) automatically processing said notification, including forwarding said notification to said first trading partner.

In the present office action, the Examiner relied on SILVERMAN for rejecting all but one element (i.e., element (g)) of claim 1. Examiner relied on GIOVANNOLI for rejecting element (g) of claim 1.

Based on the arguments presented below, Applicant respectfully submits that the combination of SILVERMAN and GIOVANNOLI fails to disclose or suggest at least one element of claim 1.

a. The SILVERMAN Reference

SILVERMAN discloses a matching system for trading instruments in which a host computer automatically matches active bids and offers. SILVERMAN, col. 3, lines 18-20 and lines 39-40. “[A]t all times the system will display the best inside price for every instrument traded on the system Preferably the prices are displayed together with the quantity bid or offered at the specified price so that the trader at the keystation can observe the market activity. By observing the market activity, the trader can decide whether to enter a bid, or enter an offer into the market in an effort to complete a matching transaction.” SILVERMAN, col. 6, lines 53-62.

b. SILVERMAN Does Not Disclose or Suggest at least element (d) recited in Claim 1

Element (d) of claim 1 recites generating a purchase order based on a portion of the trading relationship information and pricing information pertaining to at least one qualified trading partner and the purchase request, without requiring direct

communication between the first trading partner and the at least one qualified trading partner and without revealing the pricing information to the first trading partner.

Thus, for example, a seller trading partner's sales price of a product is not revealed to a buyer trading partner who wishes to purchase the product.

In contrast, SILVERMAN discloses that "at all times the system will display the best inside price for every instrument" to all traders (i.e., buyers and sellers) so the traders can decide whether to enter a bid or enter an offer. SILVERMAN, col. 6, lines 53-55 and lines 61-62. Thus, in SILVERMAN, both the buyer traders and seller traders can see the bid and offer prices for every instrument at all times.

The Examiner cited col. 10, lines 9-33 for allegedly disclosing that pricing information of one trading partner is not necessarily revealed to another trading partner (for rejecting claim 48). SILVERMAN discloses that all prices are revealed to both the buyers and sellers except a "net together price." Therefore, SILVERMAN can only make obvious the claim if the "net together price" is some form of "sales or seller's price."

The specification of SILVERMAN contains no other description of "net together" price other than in col. 10, lines 24-25. The Applicant has never heard of, and is unaware of any ordinary meaning for, the term "net together price." Indeed, a web search for the term (Google: "net together" price) reveals no hits whatsoever ("Your search - "net together price" - did not match any documents"). The term "net together price" appears to have no ascertainable meaning. Therefore, it cannot be said that SILVERMAN teaches or suggests that "net together price" is a form of "sales price" that can be withheld from the buyer.

c. GIOVANNOLI Cannot Disclose or Suggest element
(d) recited in Claim 1

As explained in the response to the previous office action, GIOVANNOLI discloses a bidding system¹ which does not include the database as recited in element

¹ "No central database of goods, prices, etc. is involved. Instead, buyers formulate requests for quotation and transmit them to the computerized network which broadcasts the request for quotation of one or more specified standard products to prospective sellers based on filter conditions" GIOVANNOLI, col. 2, lines 41-47 (emphasis added).

(a) of claim 1. As a result, GIOVANNOLI cannot disclose element (d) which refers back to the pricing information initialized into the database of element (a).

d. Commercial Success

Applicant has previously submitted evidence of commercial success of the method recited in claim 1 which has been implemented in the HP Buy-Sell process. In the present office action, the Examiner stated that little weight was given to the evidence because it was not accompanied by a declaration. A declaration from one of the inventors of the present application is attached herewith. Applicant respectfully requests the Examiner to reconsider the evidence in light of the declaration.

e. Conclusion

Based on all the foregoing, claim 1 is not obvious in view of the cited references and should be in condition for allowance.

2. Dependent Claims 2-19 & 48

Dependent claims 2-19 and claim 48 are dependent on claim 1. Based on the foregoing arguments regarding claim 1, these dependent claims should also be in condition for allowance.

B. Independent Claims 20, 21, 37, 42 and 43

Independent claims 20, 21, 37, 42, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over SILVERMAN in view of GIOVANNOLI or official notice. Applicant respectfully traverses the rejections.

Independent claims 20, 21, 37, 42, and 43 include similar limitations as discussed above regarding claim 1. Based on the foregoing arguments for claim 1, these independent claims are also not unpatentable over the cited references and should be in condition for allowance.

C. Dependent Claims 22-36, 38-41, 44-47

Claims 22-36 & 50 are dependent on claim 21. Based on the foregoing regarding claim 21, these dependent claims should also be in condition for allowance.

Claims 38-41 & 51 are dependent on claim 37. Based on the foregoing regarding claim 37, these dependent claims should also be in condition for allowance.

Claim 52 is dependent on claim 42. Based on the foregoing regarding claim 42, this dependent claim should also be in condition for allowance.

Claims 44-47 & 53 are dependent on claim 43. Based on the foregoing regarding claim 43, these dependent claims should also be in condition for allowance.

II. Conclusion

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance. Should the Examiner believe that a telephone interview would help advance the prosecution of this case, the Examiner is requested to contact the undersigned attorney.

Respectfully submitted,

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